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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,635	10/19/1999	MARK A. REILEY	1759.16690	4414
26308	7590	12/16/2004	EXAMINER	
RYAN KROMHOLZ & MANION, S.C.			MAYNARD, JENNIFER J	
POST OFFICE BOX 26618			ART UNIT	
MILWAUKEE, WI 53226			PAPER NUMBER	

3763

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary	Application No. 09/421,635	Applicant(s) REILEY	
	Examiner Jennifer J Maynard	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Objections

Claims 58-60 are objected to because of the following informalities: Firstly, Claim 58, line 2, recites "a trocar instrument", however in Claim 57, line 2, from which Claim 58 depends, "a trocar" was previously recited, therefore it is unclear if Applicant intended to introduce a second trocar in Claim 58, which is separate and distinct from the trocar of Claim 57.

Appropriate correction is required. Secondly, Claim 59, line 2, recites "a cannula instrument", however in Claim 57, line 2, from which Claim 59 depends, "a cannula" was previously recited, therefore it is unclear if Applicant intended to introduce a second cannula in Claim 59, which is separate and distinct from the cannula of Claim 57. Appropriate correction is required. Thirdly, Claim 60, lines 2 and 3, recite "a cannula" and "a trocar", respectively, however in Claim 57, line 2, from which Claim 60 depends, "a cannula" and "a trocar" were previously recited, therefore it is unclear if Applicant intended to introduce a second cannula and a second trocar in Claim 60, which are separate and distinct from the cannula and the trocar of Claim 57. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 58-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 58 recites the limitation "the first functional instrument" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 59 recites the limitation "the second functional instrument" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 60 recites the limitation "the second functional instrument" and "the first functional instrument" in lines 2 and 3, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 57-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Strasser et al. (US 4,838,282 A).

Strasser et al. discloses a tool system, as recited in Claims 57-60, comprising a composite instrument comprising a cannula (12) and a trocar (14) inserted into the cannula, the composite instrument including a composite handle (16, 18) sized and configured to be grasped by a hand to transmit rotational and/or longitudinal forces to the composite instrument sufficient to advance

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the composite instrument through tissue and/or bone, the composite handle comprising a first portion (16) coupled to the trocar and a second portion (18) coupled to the cannula, the first portion being separable from the second portion in response to withdrawal of the trocar from the cannula, the second portion having a size that is less than the size of the first portion. (Note: The Examiner has interpreted the fact that the trocar handle (16) overlaps a section of the cannula handle (18) that the trocar handle is larger in at least one dimension, i.e. depth, relative to the cannula handle, thereby anticipating Applicant's claim language.); see Figures 2, 4 and 9. With respect to Claim 61, see Figure 1. With respect to Claims 62-64, see Column 7, line 57 through Column 8, line 10. With respect to Claims 65 and 66, see Column 5, lines 24-27. With

Claims 57-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Scarfone et al. (US 5,385,151 A).

Scarfone et al. discloses a tool system, as recited in Claims 57-60, comprising a composite instrument comprising a cannula (14) and a trocar (20) inserted into the cannula, the composite instrument including a composite handle (44, 46) sized and configured to be grasped by a hand to transmit rotational and/or longitudinal forces to the composite instrument sufficient to advance the composite instrument through tissue and/or bone, the composite handle comprising a first portion (44) coupled to the trocar and a second portion (46) coupled to the cannula, the first portion being separable from the second portion in response to withdrawal of the trocar from the cannula, the second portion having a size that is less than the size of the first portion. With respect to Claim 61, see Figure 1. With respect to Claims 62-64, see Column 2, lines 42-46.

Claims 67-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Jamshidi (US 5,807,275 A).

Jamshidi discloses a tool comprising a first functional instrument, in the form of a trocar (14) including a first handle (12A), and a second functional instrument, in the form of a cannula (16) including a second handle (12B), the first functional instrument engaging the second functional instrument to form a composite instrument, the first handle mating with the second handle when the first handle is in either of a first position and a second position relative to the second handle when the first functional instrument is engaged with the second functional instrument to form a composite handle; wherein the first handle includes a first securing element, in the form of a groove (42), and wherein the second handle includes a second securing element, in the form of a key (40), and wherein the first securing element engages the second securing element when the composite handle is formed to prevent independent rotation of the first and second instruments.

Claims 67-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Byrne et al. (US 5,538,009 A).

Byrne et al. discloses a tool comprising a first functional instrument, in the form of a trocar (22) including a first handle (24), and a second functional instrument, in the form of a cannula (12) including a second handle (11, 14), the first functional instrument engaging the second functional instrument to form a composite instrument, the first handle mating with the second handle when the first handle is in either of a first position and a second position relative

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to the second handle when the first functional instrument is engaged with the second functional instrument to form a composite handle; wherein the first handle includes a first securing element, in the form of a groove (46), and wherein the second handle includes a second securing element, in the form of a key (44, 48), and wherein the first securing element engages the second securing element when the composite handle is formed to prevent independent rotation of the first and second instruments.

Claims 67-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Tretinyak (US 4,630,616 A).

Tretinyak discloses a tool comprising a first functional instrument, in the form of a trocar (14) including a first handle (16), and a second functional instrument, in the form of a cannula (12) including a second handle (18), the first functional instrument engaging the second functional instrument to form a composite instrument, the first handle mating with the second handle when the first handle is in either of a first position and a second position relative to the second handle when the first functional instrument is engaged with the second functional instrument to form a composite handle; wherein the first handle includes a first securing element, in the form of a groove (16.4), and wherein the second handle includes a second securing element, in the form of a key (18.4, 18.5), and wherein the first securing element engages the second securing element when the composite handle is formed to prevent independent rotation of the first and second instruments.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer J Maynard whose telephone number is 571.272.4961. The examiner can normally be reached on Mondays-Fridays 9:30 AM-5:30 PM; 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571.272.4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J Maynard

A handwritten signature in black ink, appearing to read 'J Maynard', is written over the printed name.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,575,919 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are merely broader than the patented claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer J Maynard whose telephone number is 571.272.4961.

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